

ALERT

Federal Circuit Patent Bulletin: *Gen. Elec. Co. v. Wilkins*

May 8, 2014

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On May 8, 2014, in *Gen. Elec. Co. v. Wilkins*, the U.S. Court of Appeals for the Federal Circuit (Lourie,* Taranto, Chen) affirmed the district court's declaratory judgment that Wilkins is not a coinventor under 35 U.S.C. § 256 of U.S. Patent 6,921,985, which related to controlling key components of a wind turbine that would allow it to remain connected to the power grid and to safely ride through a low voltage event (LVRT). The Federal Circuit stated:

Because the issuance of a patent creates a presumption that the named inventors are the true and only inventors, the burden of showing misjoinder or non-joinder of inventors is a heavy one and must be proved by clear and convincing evidence. Credibility determinations are entitled to strong deference.

[I]n light of all the record evidence, Wilkins did not prove his inventorship claim by clear and convincing evidence because he did not present any credible testimony that could be corroborated. In order to guard "against courts being deceived by inventors who may be tempted to mischaracterize the events of the past through their testimony," the law requires corroboration of a putative inventor's credible testimony, the sufficiency of which is measured under a "rule of reason" standard. Therefore, as a threshold matter, in order for the

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rule of reason requirement to even apply there must be some evidence that a fact-finder can find reasonable; the putative inventor must first provide credible testimony that only then must be corroborated. The very purpose of the rule of reason requirement is to verify the credibility of a putative inventor's story.

The district court found that Wilkins was biased, based in part on his financial relationship with Mitsubishi. The court's determination is supported by documentary evidence showing that Wilkins demanded and received substantial payments in order for him to "stay in the game" so that Mitsubishi could "manage" him. The court also found that Wilkins further undermined his own credibility while testifying at trial because his responses to even basic questions were "purposefully evasive" and he was "repeatedly impeached during cross-examination, to the point where the veracity of even simple answers w[as] called into question." Based on the trial record, we find no clear error in the district court's assessment that the substance of Wilkins's testimony, which addressed central issues such as conception and contribution, was inconsistent and purposefully evasive. We agree with the district court's conclusion that Wilkins left his case with no credibility. [W]ithout credible testimony from Wilkins, there was nothing to corroborate. And although there was no need for the district court to assess any corroborating evidence, the court nevertheless carefully and thoroughly analyzed all of the evidence presented under the rule of reason standard and concluded that it did not contain clear and convincing evidence showing that Wilkins made any inventive contribution to the claims of the '985 patent. . . .

Wilkins's argument depends on a selective reading of the record, which ignores facts that are unhelpful to his case and is in itself contrary to a proper rule of reason analysis. [H]e suggests now that the October 2002 Design and Cost Analysis that he prepared for Florida Power and Light clearly and convincingly demonstrates his contribution to the German team's LVRT solution and the claims of the '985 patent, viz., use of a UPS [(uninterruptible power supply)]. Notwithstanding that the record is devoid of proof that the German engineers relied on anything discussed in that document as part of their conception and that Wilkins provided no credible testimony for that document to corroborate, our review of the record verifies that the district court did not clearly err in finding that the document does not disclose any of the subject matter claimed in the '985 patent.

Record evidence confirms that Wilkins collected ideas from many different collaborating GE sources when preparing the Design and Cost Analysis. Wilkins himself conceded that the idea to use a UPS to perform LVRT was not novel in 2002. Accordingly, if all Wilkins allegedly contributed to the '985 patent was the idea to use a UPS, then he would have contributed nothing beyond what was already known in the art. That is not sufficient to name Wilkins as a co-inventor. . . . And the prosecution history of the '985 patent shows that it was the combination of a UPS and such a circuit that allowed GE to overcome a prior art rejection in getting its claims

allowed. . . .

A co-inventor “must contribute in some significant manner to the conception or reduction to practice of the invention [and] make contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention.” Wilkins’s evidence is bereft of any such proof. The undisputed record confirms that the German inventors had already conceived of their controller-based LVRT solution before corresponding with Wilkins to discuss American grid requirements or meeting with Wilkins in Germany. [T]he district court did not err in determining that the heavy burden of proof by clear and convincing evidence was not met, and therefore that Wilkins should not be named a coinventor of the ‘985 patent. The judgment of the district court is therefore affirmed.